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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/833,680 | 04/13/2001 | Takeshi Yukitake | JEL 29186C-RE-DIV1 | 2844 |

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James E. Ledbetter, Esq.
Stevens, Davis, Miller & Mosher, L.L.P.
1615 L Street NW, Suite 850
P.O. Box 34387
Washington,, DC 20043-4387

EXAMINER

LEE, RICHARD J

ART UNIT

PAPER NUMBER

2613

DATE MAILED: 08/22/2003

J

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.
09/833,680

Applicant(s)
Yukitake et al

Examiner
Richard Lee

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2613



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-6 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 07/970,046.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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1. It is noted that the continuation data as shown at line 1 of the first page of the single column format Specification should be provided in the double column format Specification. In addition, the applicants have identified under the continuation data two related divisional reissue applications filed April 12, 2001, respectively, but have failed to provide the serial numbers for such applications. Such serial numbers should be provided/updated under the continuation data for completeness and as required by 37 CFR 1.177. The other co-pending reissue applications that the Examiner is aware of at this time include applications 09/833,769; 09/866,811; and 09/833,770. The continuation data should be updated with these co-pending reissue applications as well. Also, the particular identification of “(now U.S. Patent no.)” for application number 09/559,627 as shown in the continuation data should be deleted since the application referenced is still pending and has not yet been allowed at the present time. It is further noted that though the request filed October 15, 2001 for the correction of Domestic Priority as “This application is a DIV of 09/559,627, 04/27/2000 which is a REI of 08/278,010, 07/20/1994 PAT 5,745,182 which is a DIV of 07/970,046, 11/02/1992 PAT 5,369,449”, the continuation data as provided at line 1 of the first page of the single column format Specification does not reflect this change. The continuation data should be amended in the double column format Specification accordingly.
2. It is noted that the cited Gillard patent no. 4,864,294 as shown in the IDS filed April 13, 2001 is incorrect. The reference should be patent no. 4,864,394 instead. The Examiner has made the correction in the IDS filed April 13, 2001 (see attached PTO-1449). No further action is required by the applicants.

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3. The applicants are informed that the Statement Under 37 CFR 3.73(b) and the Assent of Assignee as filed are defective since both communications have failed to provide the required dates when signed.

4. It is noted that the Offer to Surrender as filed does not provide a date when the communication was signed. Though there is no longer a requirement for the applicant to provide a statement as to the offer to surrender the original patent, the original patent is still required to be surrendered. And since the Letters Patent No. 5,745,182 has already been surrendered in parent application 09/559,627, no further action is required by the applicants.

5. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The reissue declaration as filed is defective since it is a duplicate of that filed in parent case 09/559,627. The error(s) set forth and corrected in the present reissue application can not be the same error(s) being corrected in the parent reissue application 09/559,627. The present reissue declaration must provide/state new error(s) for correction.

6. Claims 4-6 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claim 5 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of copending Application No. 09/833,770. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the followings. The difference between application claim 5 and claim 7 of 09/833,770 are as follows. Application claim 5 claims "one reference image R1" and "another reference image R2" while claim 7 of '770 claims "a reference image part r1 of one reference image R1" and "a reference image part r2 of another reference image R2". However, after a careful reading of the Specification, it is determined that both the "reference image parts r1 and r2" and "one and

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another reference images" correspond to the block unit (see Abstract for example). In addition, the preamble of application claim 5 claims a method of **obtaining** a motion-compensated image and the preamble of claim 7 of '770 claims a method for **determining** a motion compensated image. The difference between the two limitations are the terms "obtaining" and "determining", but the two terms are substantially the same and are not patentably distinct from each other since it is clear that after something is determined, you would have obtained it and vice versa. In addition, application claim 5 calls for "**obtaining** a first motion vector MV1" while claim 7 of '770 calls for "**providing** a first motion vector MV1". Again, the two terms "obtaining" and "providing" are substantially the same and are not patentably distinct from each other. Further, application claim 5 calls for "calculating **first pixel values** of said one reference image R1 from pixels which are **neighbors** of positions corresponding to said first motion vector MV1 and calculating **second pixel values** of said another reference image R2 from pixels which are **neighbors** of positions corresponding to said second motion vector MV2", while claim 7 of '770 calls for "calculating **pixel values** of said reference image parts r1 and r2 from **peripheral pixels** of positions corresponding to said first and second motion vectors MV1 and MV2". The differences between the two limitations are the terms "first and second pixel values" versus "pixel values"; and "pixel which are neighbors of positions" versus "peripheral pixels". However, the terms "first" and "second" pixel values as claimed only identifies the pixel values but does not add any patentable weight over the simple "pixel values" as claimed in '770. After a careful reading of the Specification, it is determined that both "peripheral pixels" and "pixels which are neighbors of

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positions” correspond to the same pixel positions (see Figures 4A and 4B), and as such are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

(for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Lee whose telephone number is (703) 308-6612. The Examiner can normally be reached on Monday to Friday from 8:00 a.m. to 5:30 p.m, with alternate Fridays off.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group customer service whose telephone number is (703) 306-0377.


RICHARD LEE
PRIMARY EXAMINER

Richard Lee/rl



8/14/03